

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 14446US02

PATENT

In the Application of:)
)
Jeyhan Karaoguz, et al.) **Electronically Filed On December 1, 2010**
)
Serial No.: 10/672,664)
)
Filed: September 26, 2003)
)
For: MEDIA EXCHANGE NETWORK)
SUPPORTING DELIVERY OF MEDIA)
CONTENT TO AUTHORIZED)
VEHICLES VIA MEDIA)
PROCESSING SYSTEM)
)
Examiner: Luong, Alan H.)
)
Group Art Unit: 2427)
)
Confirmation No.: 9798)

SECOND PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Paper responds to the Final Office Action mailed September 1, 2010.

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: December 1, 2010

By: /Joseph M. Butscher/
Joseph M. Butscher
Reg. No. 48,326
Attorney for Applicants

REMARKS

The present application includes pending claims 1-7, 9-18, 20-34 and 36-61, all of which stand rejected.

As an initial matter, the Applicants note that this is the Second Pre-Appeal Brief Request for Review. In response to the November 19, 2009 Pre-Appeal Brief Request for Review, the Panel reopened prosecution, thereby acknowledging that the Examiner failed to establish a *prima facie* case of unpatentability with respect to at least some of the claims. See January 11, 2010 Notice of Panel Decision from Pre-Appeal Brief Review.

As explained below, the present Final Office Action also fails to establish a *prima facie* case of unpatentability with respect to the pending claims.

The Applicants demonstrate that the Office Action fails to establish that the proposed combination of Lee in view of Lavelle renders claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, and 60-61 unpatentable. See June 11, 2010 Response at pages 16-21.

With respect to independent claims 1, 14, 25, and 31, the Applicants demonstrate that the Office Action errs in asserting that Lee discloses all the limitations, except for “transfer of a video game to one or both of the entertainment system and/or a handheld electronic game system via the at least one vehicle system.” See *id.* at pages 16-20.

The Applicants demonstrate that, contrary to the assertions in the Office Action, Lee does not describe, teach, or suggest “set top box circuitry,” as recited in claim 1, for example. See *id.* at pages 17-19. Instead, Lee discloses a system that “consists of (1) a remotely programmable, microcomputer controlled multimedia device 20 in a vehicle with a wireless IP address for Internet access, (2) an Internet gateway network 30 that provides programming, information and Internet access to the multimedia device 20, and (3) one or more remote programming devices 40.” See Lee at column 6, lines 8-14 (emphasis added). “Consists of” is a **close-ended** phrase. See, for example, MPEP at 2111.03

The Applicants note that reference numeral 30, which the Office Action relies on as “set top box circuitry” (see September 1, 2010 Office Action at page 7) is an “Internet gateway network” (see Lee at column 6, line 11), but **not set top box circuitry**. Instead, the “gateway 30 serves as an Internet Service Provider to vehicles 184 through various forms of wireless transmission 186.” See Lee at column 11, lines 11-13.

As the Applicants previously explained, **through evidentiary support**, a television set-top box is different than, and includes functionality not found in, the internet gateway network of Lee. Indeed, the Microsoft Press Computer Dictionary, 3rd Edition, at page 431 (previously provided), indicates that a “set-top box” is a “device that converts a cable TV signal to an input signal to the TV set.” It is also well known in the art that a “set-top box” is a device that converts a satellite TV signal to an input to the TV set.

There is nothing in Lee that describes, teaches, or suggests that the “Internet Gateway 30” connects to a television. Lee also does not describe, teach or suggest that the “Internet Gateway 30” connects to a “cable TV network,” or processes “cable TV signals,” or “satellite TV signals.” Again, the Internet Gateway 30 of Lee is by no means a set-top box, as recited in the claims of the present application.

The Office Action provides a series of conclusory statements that the Internet Gateway 30 of Lee is somehow set-top box circuitry. *See* September 1, 2010 Office Action at pages 2-3, and 7-8. Thus, in response to the Applicants providing actual evidence as to the nature of a set-top box, the Office Action provides a series of conclusory statements that attempt to equate a gateway with set-top box circuitry remotely located from an authorized vehicle. *See id.*

Such an examination process clearly runs afoul of Federal Circuit case law.

KSR did not free the PTO’s examination process from explaining its reasoning. In making an obviousness rejection, the examiner **should not rely on conclusory statements** that a particular feature of the invention would have been obvious or is well known. Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion. Generally, **the examiner cites prior art references to demonstrate the state of knowledge.**

See In re Vaidyanathan, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

The Applicants respectfully submit that Federal Circuit case law, as well as the MPEP, prohibits the Examiner from making conclusions based on subjective understandings or experience, as the Examiner is attempting to do with respect to the limitations noted above. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would

be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings”).

As explained above, Lee does not describe, teach or suggest a “set top box circuitry” remote from a vehicle and a vehicle system, in particular, or “set top box circuitry,” in general, as the Office Action contends. Accordingly, the Office Action has committed clear error, and has failed to establish a *prima facie* case of unpatentability with respect to the claims for at least these reasons.

The Applicants note, however, that if the Examiner and supervisor believe that amending to “set top box” instead of “set top box circuitry” would expedite prosecution towards allowance,¹ the Applicants would agree to such an Examiner’s Amendment. Indeed, if the Examiner and supervisor are considering any Examiner’s Amendment² that would expedite prosecution towards allowance, the Applicants respectfully request that the Examiner contact the undersigned attorney. In short, the Applicants would like to work with the Examiner to expedite prosecution towards allowance, and would be willing to agree to a reasonable Examiner’s Amendment.

Additionally, the Applicants demonstrate that the Office Action has not established that any of the cited references describes, teaches, or suggests “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.**” See June 11, 2010 Response at pages 19-20. For at least these additional reasons, the Office Action fails to establish a *prima facie* case of unpatentability with respect to the pending claims.

Regarding claim 11, the Applicants respectfully submit that the Office Action seemingly admits that Lee does not teach the subject matter of claim 9 from which claim 11 depends, and the Office Action does not show that Lee teaches the cited “Internet gateway network 30” containing “user profiles databases 198” is a “media peripheral” of the “vehicle multimedia receiver (20).” *Id.* at page 13.

¹ The Office Action alludes to the difference between “set top box circuitry” and a “set top box.” See September 1, 2010 Office Action at pages 2-3.

² The Office Action notes that the “features upon which applicant relies ... are not recited in the rejected claims.” See *id.* at pages 4-5.

Also, the Applicants demonstrate that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claims 40, 46, 52, and 58. *See id.* at pages 20-21.

Moreover, referring to the PTO's published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite **seven rationales** supporting an obviousness rejection and give specific findings that **must be made** by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are **not optional and must be articulated by the Examiner for the rationale to apply.**

The Office Action is unclear as to which Rationale it uses to reject the claims. Further, the Office Action seemingly does not provide **all** of the **required** factual findings.

"It is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in KSR and discussed in the 2007 KSR Guidelines, they are to adhere to the instructions provided in the MPEP regarding the **necessary** factual findings." *See* September 1, 2010 Examination Guidelines Update (emphasis added).

Further, it is "Office policy that appropriate factual findings are **required** in order to apply the enumerated rationales properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel **must** either withdraw the rejection, or repeat the rejection including all the required factual findings." *See id.* (emphasis added).

The Applicants previously paid the fee for the Notice of Appeal. *See* November 19, 2009 Notice of Appeal. Nevertheless, the Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: December 1, 2010

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

Respectfully submitted,

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326